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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,541	09/19/2003	Jean-Marc Bachot	TI-27700A	4292

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EXAMINER

ELMORE, STEPHEN C

ART UNIT	PAPER NUMBER
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2186

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/664,541

Applicant(s)

BACHOT ET AL.

Examiner

Stephen Elmore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19-27, 37, 38 and 40-63 is/are allowed.
- 6) ☒ Claim(s) 28 and 39 is/are rejected.
- 7) ☒ Claim(s) 29-36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119


- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/410,772.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____


STEPHEN C. ELMORE
PRIMARY EXAMINER

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DETAILED ACTION

1. This Office action is in response to the petition and amendment filed April 19, 2005, the amendment amending claims 27, 31, 38-40, 43-45, 47-49, 61, and adding new claims 62 and 63.
2. Claims 19-63 remain for examination.

Claim Objections

3. The objections to the claims are withdrawn.

Claim Rejections - 35 USC § 112

4. The rejections of claims 31, 40 and 43 under 35 USC § 112, second paragraph, are withdrawn.
5. The rejection of claim 39 under 35 USC § 112, second paragraph, is maintained due to lack of antecedent basis of the language "the hold time".

Double Patenting

6. The rejection of claim 28 under the judicially created doctrine of obvious-type double patenting is maintained.

Claim Rejections - 35 USC § 102

7. The rejections under 35 USC § 102 are withdrawn.

Allowable Subject Matter

8. Claims 19-27, 37, 38, and 40-63 are allowed over the prior art of record.
9. Claims 29-36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

10. Applicant's arguments filed April 19, 2005 have been fully considered but they are not persuasive with respect to the judicially created doctrine of obvious-type double patenting rejection of Claim 28.

As to the Remarks:

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a. that "the Examiner has cited no case law or statutory authority that justifies the determination (i.e., the judicially created doctrine of obvious-type double patenting rejection)"

this argument is not persuasive because in fact the following justification and attendant case law was cited with respect to the obvious-type double patenting rejection --

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.

See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obvious-type double patenting because the claims at issue were obvious over claims in four prior art patents); *In re Berg*, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obvious-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). *ELI LILLY AND COMPANY v BARR LABORATORIES, INC.*, United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 1053, 29 USPQ2d 2010, 2016 (Fed. Cir. 1993); *In re Gosteli*, 872 F.2d 1008, 1010, 10 USPQ2d 1614, 1616 (Fed. Cir. 1989); *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 782, 227 USPQ 773, 779 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d at 944, 214 USPQ at 767 (C.C.P.A. 1982)." *ELI LILLY AND COMPANY v BARB LABORATORIES, INC.*, United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

b. that "the Examiner has not addressed the issue of why it would be obvious to remove elements from Claim 27 to arrive at Claim 28",

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this argument is not persuasive because this exact issue was in fact addressed in the explanation of the rejection, i.e., that *In re Berg* affirmed a holding of obvious-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus, and because the rejection established that rejected Claim 28 had the same "genus-species" relationship to Claim 27 of the patent, as in the case law *In re Berg*.

Conclusion


11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Elmore whose telephone number is (571) 272-4436. The examiner can normally be reached on Mon-Fri from 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Kim can be reached on (571) 272-4182. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


STEPHEN C. ELMORE
PRIMARY EXAMINER

Computer Architecture - Memory Access & Control

October 2, 2005